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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/691,806	10/21/2003	Steven P. Barton	112703-294	6662

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EXAMINER	
SHAPIRO, JEFFERY A	
ART UNIT	**PAPER NUMBER**
3653	

DATE MAILED: 04/30/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary	Application No.	Applicant(s)	
	10/691,806	BARTON ET AL.	
	Examiner	Art Unit	
	Jeffrey A. Shapiro	3653	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☒ Responsive to communication(s) filed on *21 October 2003*.

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *44-68,76 and 98-101* is/are pending in the application.

4a) Of the above claim(s) *62-64 and 98-101* is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☒ Claim(s) *44-61,65-68 and 76* is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).

11)☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

12)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____.

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

1) ☒ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08) Paper No(s)/Mail Date *1/26/04*.
4) ☐ Interview Summary (PTO-413) Paper No(s)/Mail Date. _____.
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other: _____.

DETAILED ACTION

Election/Restrictions

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

   I. Claims 44-61, 65-68 and 76, drawn to a method of operating an automated checkout, classified in class 700, subclass 236.

   II. Claims 62-64, drawn to a method of generating revenue, classified in class 705, subclass 400.

   III. Claims 98-100, drawn to a method of operating a point of purchase device concerning inventory tracking, classified in class 705, subclass 22.

   IV. Claim 101, drawn to a method for operating a point of purchase device concerning developing and using a consumer profile, classified in class 705, subclass 10.

The inventions are distinct, each from the other because of the following reasons:

2. Inventions I and II are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the method of operating the checkout counter does not need the details of generating revenue to be patentable. The subcombination has separate utility such as to generate revenue by obtaining a fee from a product supplier.

3. Inventions I and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the method of operating the checkout counter does not need the details of inventory tracking to be patentable. The subcombination has separate utility such as a method for inventory tracking.

4. Inventions I and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the method of operating the checkout counter does not need the details of obtaining a consumer profile to be patentable. The subcombination has separate utility such as to obtain a consumer profile.

5. Inventions II and III are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the

particulars of the subcombination as claimed because the method of generating revenue is does not need the details of inventory tracking to be patentable. The subcombination has separate utility such as a method for inventory tracking.

6. Inventions II and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the method of generating revenue is does not need the details of obtaining a consumer profile to be patentable. The subcombination has separate utility such as a method for obtaining a consumer profile.

7. Inventions III and IV are related as combination and subcombination. Inventions in this relationship are distinct if it can be shown that (1) the combination as claimed does not require the particulars of the subcombination as claimed for patentability, and (2) that the subcombination has utility by itself or in other combinations (MPEP § 806.05(c)). In the instant case, the combination as claimed does not require the particulars of the subcombination as claimed because the method of inventory tracking does not need the details of obtaining a consumer profile to be patentable. The subcombination has separate utility such as a method for obtaining a consumer profile.

8. Because these inventions are distinct for the reasons given above and the search required for Group I is not required for Groups II-IV, restriction for examination purposes as indicated is proper.

9. During a telephone conversation with Attorney Robert M. Barrett on 4/21/04 a provisional election was made without traverse to prosecute the invention of Group I, Claims 44-61, 65-68 and 76. Affirmation of this election must be made by applicant in replying to this Office action. Claims 62-64 and 98-101 are withdrawn from further consideration by the examiner, 37 CFR 1.142(b), as being drawn to a non-elected invention.

10. Applicant is reminded that upon the cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a request under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

Claim Rejections - 35 USC § 103

11. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

> (a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negatived by the manner in which the invention was made.

12. Claims 44, 48-50, 56, 65, 67 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perlin, Jr. et al (US 6,356,794 B1) in view of Dejaeger et al (US 6,213,395 B1). Perlin discloses the following.

As described in Claims 44, 48-50, 56, 65, 67 and 76 ;

a. allowing a consumer to bring purchasable items to a checkout device (33);

b. scanning the items and accumulating a cost for the scanned items on a display (33) (see Perlin, col. 4, lines 18-24);

c. allowing the consumer to select a product from a dispensing device (29) located in juxtaposition to the automated checkout;

d. automatically dispensing the product from the dispensing device in response to the consumer's selection (see Perlin, col. 4, lines 24-31); and

e. automatically adding a cost of the product to the cost for the scanned items on the display (see Perlin, col. 4, lines 42-56, col. 5, lines 12-21, (note that the credit value is entered into the POS terminal (33) and retail module (38));

Perlin does not expressly disclose, but Dejaeger discloses the following.

As described in Claims 44, 48-50, 56, 65, 67 and 76 ;

f. allowing a consumer to bring purchasable items to an *automated* checkout device (10) (see Dejaeger, abstract, for example);

g. *allowing the consumer to scan* the purchasable items and accumulate a cost for the scanned items on a display (see Dejaeger, abstract, for example);

Both Perlin and Dejaeger are considered to be analogous art as they both concern use of checkout counters at a retail point of sale (POS) system.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have replaced the checkout counter of Perlin with the checkout counter of Dejaeger.

The suggestion/motivation would have been to provide a checkout counter which can be used in either a self-service or assisted checkout mode. See Dejaeger, col. 2, lines 61-67, col. 3, lines 1-16, col. 4, lines 3-12 and col. 6, lines 5-38.

Therefore, it would have been obvious to obtain the invention as described in Claims 44, 48-50, 56, 65, 67 and 76.

13. Claims 45-47. 51-55, 57-61, 66 and 68 are rejected under 35 U.S.C. 103(a) as being unpatentable over Perlin, Jr. et al (US 6,356,794 B1) in view of Dejaeger et al (US 6,213,395 B1) and further in view of Walter. Perlin and Dejaeger disclose the apparatus as described above. Perlin further discloses the following.

As described in Claims 46, 51 and 60;

h. including the step of allowing the consumer to pay for the product by credit/debit card (see Perlin, col. 4, lines 18-22);

As described in Claim 47;

i. adding the cost of the product includes automatically increasing a balance due on a credit/debit card transaction (see Perlin, col. 4, lines 18-22, noting that this is how credit card systems work);

As described in Claims 54, 55, 58 and 59;

j. allowing a retail operator or customer to enter the consumer's approval to purchase the product (see Perlin, col. 4, lines 18-22);

As described in Claim 68;

k. the point of purchase product is dispensed from a device that is integral with the device that identifies costs (see Perlin, figure 2, for example);

Perlin does not expressly disclose, but Walter discloses the following;

As described in Claim 45;

l. the consumer selects the product by using a touch screen (32) (see Walter, col. 4, lines 64-67);

As described in Claim 52;

m. the consumer is prompted that the product is available by an advertisement for the product (64)(see Walter, figure 6 and col. 9, lines 34-41) ;

As described in Claims 53, 61 and 66;

n. prompting the consumer includes prompting the consumer at a time selected from the group consisting of:

i. before the consumer purchases the other consumable items,

ii. while the consumer is purchasing the other items and

iii after the consumer purchases the other items;

(Note that the instructions, which include advertisements are intended to be advertisements which are periodically placed in the message area, and that the animated character (62), which may be in the form of a product, is intended to be in view of the customer all of the time. See col. 9, lines 9-14. Note also that each element of the group is considered to be a functional equivalent of each other.)

As described in Claim 57;

o. prompting the consumer that the products are available includes displaying a dynamic display selected from the group consisting of;

i. a display of the products (see figure 6, element (62),

ii. a message concerning the products (see fig. 6, element (64),

iii. an advertisement concerning the products (see fig. 6, elements 62 and 64), and

iv. a price reduction concerning the products (note that it would have been obvious to provide a message such as this as it is considered to be another form of advertising);

(Note that the instructions, which include advertisements are intended to be advertisements which are periodically placed in the message area, and that the animated character (62), which may be in the form of a product, is intended to be in view of the customer all of the time. See col. 9, lines 9-14. Note also that each element of the group is considered to be a functional equivalent of each other.)

Perlin, Dejaeger and Walter are considered to be analogous art as they concern use of checkout counters at a retail point of sale (POS) system.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have used a touch screen for the display and to use the instructional prompts, messages and advertisements in the checkout counter system of Perlin, as taught by Walter.

The suggestion/motivation would have been to provide a checkout counter which "provides instruction to a customer while also conveying an advertising message." See Walter, col. 3, lines 23-27, col. 4, lines 58-67 and col. 6, lines 10-22. Note also that a touch screen is construed to be a functional equivalent to a non-touch display or a voice generation device.

Therefore, it would have been obvious to obtain the invention as described in Claims 44, 48-50, 56, 60, 65, 67 and 76.

14. Claims 44, 48-50, 56, 65, 67 and 76 are rejected under 35 U.S.C. 103(a) as being unpatentable over Bustos (US 5,816,443) in view of Walter et al (US 5,992,570). Bustos discloses the following.

As described in Claims 44, 48-50, 56, 65, 67 and 76 ;

a. allowing a consumer to bring purchasable items to a checkout device (see Bustos, fig. 5a);

b. scanning the items and accumulating a cost for the scanned items on a display (33) ((see Bustos, fig. 1, which illustrates a monitor near element (127) and fig. 5a, which illustrates a clerk scanning items);

c. allowing the consumer to select a product(47b) from a dispensing device (20b) located in juxtaposition to the automated checkout (see Bustos, fig. 5a);

d. automatically dispensing the product from the dispensing device in response to the consumer's selection (see Bustos, fig 5a); and

e. automatically adding a cost of the product to the cost for the scanned items on the display (see Bustos, col. 8, lines 1-49);

Bustos does not expressly disclose, but Walter discloses the following.

As described in Claims 44, 48-50, 56, 65, 67 and 76 ;

f. allowing a consumer to bring purchasable items to an *automated* checkout device (10) (see Walter, col. 2, lines 15-19, for example);

g. *allowing the consumer to scan* the purchasable items and accumulate a cost for the scanned items on a display (see Walter, Claim 8, for example);

Both Bustos and Walter are considered to be analogous art as they both concern use of checkout counters at a retail point of sale (POS) system.

At the time of the invention, it would have been obvious to one of ordinary skill in the art to have replaced the checkout counter of Bustos with the checkout counter of Walker.

The suggestion/motivation would have been to speed customer throughput by speeding up the checkout process. See Walter, col. 2, lines 15-19.

Therefore, it would have been obvious to obtain the invention as described in Claims 44, 48-50, 56, 65, 67 and 76.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jeffrey A. Shapiro whose telephone number is (703)308-3423. The examiner can normally be reached on Monday-Friday, 9:00 AM-5:00 PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Donald P. Walsh can be reached on (703)306-4173. The fax phone number for the organization where this application or proceeding is assigned is 703-872-9306.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see http://pair-direct.uspto.gov. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Jeffrey A. Shapiro
Examiner
Art Unit 3653

April 27, 2004

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